REMARKS

This Amendment is in response to the final Office Action mailed October 20, 2005. Claims 1-11 and 19-20 were examined in the Office Action. Claims 1-11 and 19-20 were rejected. Claims 12-18 are canceled and no new claims have been added. Applicants respectfully request reconsideration and continued examination in view of the following remarks.

Claim Rejections - 35 U.S.C. § 112

Claims 1-11, 19 and 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The Office Action states:

> The claims contain subject matter which were not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. (pg 2 ¶ 3)

Claims 1 and 5 have been amended to claim subject matter which is "described in the specification in such a way as to enable one skilled in art to which it pertains, or with which it is most nearly connected, to make and/or use the invention" as required by 35 U.S.C. §112 first paragraph. Claims 1 and 5 has been amended to address the rejection, and Applicants submit that the amendments overcome the rejection and add no new matter. Applicants also respectfully submit that claims 1, and 5 are in condition for allowance.

Claim 19 has also been amended to overcome a rejection for indefiniteness and now describes what type of dialog is invoked.

Regarding claims 2-10, 19, and 20, Applicants submit that claims 2-10, 19, and 20 are in condition for allowance by virtue of their dependency on amended claims 1 and 5. MPEP §2143.03 citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Accordingly, Applicants respectfully request reconsideration of the 35 U.S.C. §112 first paragraph rejection to the claims 1-11, 19, and 20.

Regarding the Examiner's response to previous arguments and additional assertions, which have not been addressed specifically, Applicants respectfully submit that these arguments are moot in view of the above comments and the amendments to the claims. Accordingly, in

view of the above arguments, Applicants respectfully submit that claims 1-11, 19, and 20, even without amendment, are in condition for allowance.

Claim Rejections - 35 U.S.C. § 102

Claims 1, 3, 6, 19 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Montoyama et al., U.S. Patent No. 6,662,225 (hereinafter Montoyama). Applicants respectfully submit that Montoyama does not teach or suggest each and every feature of Applicants' amended independent claims 1 and 5.

Claim 1

Applicants' amended claim 1 is drawn to a client-side system stored on a computer, wherein the client-side system logs, in a logging file, user interactions performed within an application program module and periodically uploads the logging files to a remote server system for analysis of the logging file. The client-side system comprises, *inter alia, a set-up program module* to allow a user a choice as to where they want logging to occur, a logging code in communication with the application program module, wherein the logging code comprises a plurality of hooks into the application program module and an *operating system* of the computer, wherein when features of the application program module is used, one of the plurality of hooks is triggered and a data record is generated.

In contrast, Applicants respectfully traverse the rejection and maintain that Montoyama discloses objects that only monitor and log user actions when a user selects predetermined function keys not any user interaction with the application program as recited in amended claim 1. (See Montoyama, column 12 lines 66- column 13, lines 1-2, 14-16, and 33-34; column 16, lines 48-49; and column 31, lines 10-12). Clearly, Montoyama is focused on logging data only when certain user actions with the application program occur. Thus, Montoyama does not anticipate amended claim 1.

Also, Montoyama does not disclose a logging code comprising hooks into an *operating system* of a computer as recited in claim 1. Montoyama does not mention *operating system* hooks anywhere in the disclosure. MPEP §2131 citing *Verdegall Bros. V. Union Oil Co. of*

California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) states, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Thus, even without amendment, claim 1 is allowable over Montoyama, as Montoyama does not mention an *operating system*.

Claim 1 has been amended to include a *set-up program module* that will allow a user to decide if they wish to have their activities logged and/or participate in a study. Montoyama does not disclose either a *set-up program module* or allowing users to decide if their activities will be monitored or if they will participate in any studies. Montoyama's logging system is preinstalled and is therefore part of the overall system and not a user add-on.. Thus, claim 1 is allowable over Montoyama due to Montoyama's failure to teach *set-up program modules* that permit user choice for participating in a study. (MPEP §2131)

Regarding claims 2 and 3, Applicants submit that claims 2 and 3 are in condition for allowance by virtue of their dependency on amended claims 1. MPEP §2143.03 citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Accordingly, Applicants respectfully request reconsideration of the 35 U.S.C. §102(e) rejection to the claims 2 and 3.

Regarding claims 6, 19, and 20, Applicants submit that rejection of claims 6, 19, and 20 is improper. Claims 6, 19, and 20 are dependent on claim 5, which is not rejected under 35 U.S.C. §102(e). By virtue of their dependence on a non-rejected claim they are not anticipated. (MPEP §2143.03)

Regarding the Examiner's response to previous arguments and additional assertions, which have not been addressed specifically, Applicants respectfully submit that these arguments are moot in view of the above comments and the amendment to the claims. Accordingly, in view of the above arguments, Applicants respectfully submit that claims 2, 3, 6, 19, and 20, even without amendment, are in condition for allowance.

Claim Rejections - 35 U.S.C. § 103

Claims 2 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montoyama in view of Burgess et al., U.S. Patent No. 5,796,633 (hereinafter Burgess).

Claim 5

Applicants' amended claim 1 is drawn to a computer-implemented method for tracking any user interactions with a software application program module stored on the user's computer. The method comprises, *inter alia*, *allowing a user to determine if they wish to have interactions with the software application program module logged*; determining if any user interaction performed in the software application program module have occurred; recording the user interaction in a logging file on the computer; determining that a scheduled event is triggered during a predetermined time period; in response to the scheduled event triggering during the predetermined time period, determining whether the logging file exists, and, if so, then uploading the logging file to a remote analysis server.

As described above with respect to amended claim 5, neither Montoyama nor Burgess alone, or in combination teach or suggest *allowing a user to determine if they wish to have interactions with the software application program module logged* as recited in claim 5. Thus, claim 7, which depends from claim 5, is allowable over Montoyama in view of Jawahar for at least these reasons. Courts have generally recognized that a showing of a *prima facie* case of obviousness necessitates three requirements: (i) some suggestion or motivation, whether in the references themselves or in the knowledge of a person of ordinary skill in the art to modify the reference or combine the reference teachings; (ii) a reasonable expectation of success; and (iii) the prior art references must teach or suggest all claim limitations. MPEP §2143; *In re Dembiczak*, 175 F.3d 994 (Fed. Cir 1999); *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998); *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573 (Fed. Cir. 1996). The references used in the Office Action fail at least the third prong of obviousness in that the prior art references do not teach or suggest all claim limitations, especially, *allowing a user to determine if they wish to have interactions with the software application program module logged*. Accordingly, Applicants respectfully request reconsideration of the rejection to claim 5.

Regarding claim 2, Applicants submit that rejection of claim 2 is improper. Claim 2 is dependent on claim 1, which is not rejected under 35 U.S.C. §102(a). Thus, by virtue of claim 2's dependence on a non-rejected claim, claim 2 is not made obvious. (MPEP §2143.03)

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Montoyama and Burgess in view of Jawahar et al., U.S. Patent No. 6,256,620 (hereinafter Jawahar). At least for the reasons state above with respect to amended claims 1 and 5 Montoyama discloses objects that only monitor and log user actions when a user selects predetermined function keys not any user interaction with the application program as recited in amended claim 7. Claim 7 inherits the features of amended claim 7. Thus, neither Montoyama, Burgess, or Jawahar alone, or in combination teach or suggest each and every feature of amended claim 7. Therefore, claim 7 is allowable over Montoyama and Burgess in view of Jawahar.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Montoyama, Burgess and Jawahar in view of Ploetz et al., U.S. Patent No. 6,738,798 (hereinafter Ploetz). At least for the reasons state above with respect to amended claims 1 and 5 Montoyama discloses objects that only monitor and log user actions when a user selects predetermined function keys not any user interaction with the application program as recited in amended claim 8. Claim 8 inherits the features of amended claim 5. Thus, neither Montoyama, Burgess, Jawahar or Ploetz alone, or in combination teach or suggest each and every feature of claim 8. Therefore, claim 8 is allowable over Montoyama, Burgess, Jawahar in view of Ploetz.

Claims 4 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montoyama, Burgess, Jawahar, and Ploetz in view of Godfrey et al., U.S. Patent No. 6,662,217 (hereinafter Godfrey). At least for the reasons state above with respect to amended claims 1 and 5 Montoyama discloses objects that only monitor and log user actions when a user selects predetermined function keys not any user interaction with the application program as recited in amended claims 1 and 5. Claims 4 and 9-11 inherit the features of amended claims 1 and 5 respectively. Thus, neither Montoyama, Burgess, Jawahar, Ploetz or Godfrey alone, or in combination teach or suggest each and every feature of amended claim 4 and 9-11. Therefore, claims 4 and 9-11 is allowable over Montoyama, Burgess, Jawahar, Ploetz in view of Godfrey.

Regarding the Examiner's response to previous arguments and additional assertions, which have not been addressed specifically, Applicants respectfully submit that these arguments are moot in view of the above comments and the amendment to the claims.

CONCLUSION

In view of the above amendments and remarks, Applicants respectfully request a Notice of Allowance. If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

No fees are believed to be due; however, the Commissioner is hereby authorized to charge any fees that may be required or credit any overpayment to Deposit Account No. 13-2725.

Respectfully submitted,

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